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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,910	11/08/2000	Edward J. Walters	26495.101US02	9069
7590		12/27/2005		
Fastcase, Inc. P.O. Box 26055 Alexandria, VA 22313			EXAMINER ROBINSON, GRETA LEE	
			ART UNIT	PAPER NUMBER
			2168	
DATE MAILED: 12/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/707,910	Applicant(s) WALTERS ET AL.	
	Examiner Greta L. Robinson	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-24,26-30,34-67,71,74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-15,21-24,26-30,34-39,50-67,71,74 and 75 is/are rejected.
- 7) ☒ Claim(s) 16-20 and 40-49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4, 6-24, 26-30, 34-67, 71, 74 and 75 are pending in the present application.
2. Claims 5, 25, 31-33, 68-70 and 72-73 are cancelled. Claims 2, 4, 6-7, 16, 22, 23, 26, 34, 40, 45, 58, 59 and 71 have been amended.

Response to Arguments

3. Applicant's arguments with respect to claims 1-4, 6-24, 26-30, 34-67, 71, 74 and 75 have been considered but are moot in view of the new ground(s) of rejection.

In the response Applicant argued the following points:

(a) Barr teaches simultaneous display of identifiers and secondary bibliographic information; however does not teach display of any actual work that is identified as part of the results display.

(b) Jones teaches the simultaneous display of information about a publication along with an image of a portion of the publication; and does not deal with search queries or how to display the results of a query.

(c) Bar and Jones teach away from the claimed invention, each teaching a text of a file should be shown after the file is selected by the user see Barr col. 14 line 66 to col. 15 line 16; and Jones col. 12 lines 11-14. There is no suggestion to combine the cited references.

In response to argument (a), applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *any actual work that is identified as part of the results display*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant agrees that the prior art reference Barr et al. teaches simultaneous display of identifiers. A second look at Barr et al reveals that he teaches the claimed limitation "displaying simultaneously content elements of at least one of the records" note "PC 104 together with software 106 display the text or multi-media information retrieved by the session server 114 in a second display window ...FIG. 4B ... showing first and second windows 347, 348 which respectively display text information corresponding to text document file 345 and video image ... **the information displayed in windows 347 and 348 may be displayed simultaneously with search results list**" [note col. 15 lines 16 through line 48]. Note the display of text or image is a content element, also content information can include bibliographic information.

Regarding arguments (b) and (c), Jones has been dropped because the scope of the claims can read on Barr et al. However the examiner notes that Jones is concerned with search queries and how to display search results [note: simultaneous text/image display of publication col. 8 lines 19-34; col. 14 lines 39-61]. Applicant argues Barr et al. teaches a text of a file should be shown after the file is selected at col. 14 line 66 through col. 15 line 16; but this is an alternate step. Also note Barr et al. teaches

simultaneous display of information within windows at col. 15 lines 18-48 also note citations below in Office Action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4, 6-15, 21-24, 26-30, 34-39, 50-67, 71 and 74-75 rejected under 35 U.S.C. 102(e) as being anticipated by Barr et al. US Patent 5,873,076.

Regarding claim 1, **Barr et al.** teaches a method for displaying records responsive to a database query wherein the records are characterized by having identifiers and content elements [note: query server 116, figure 3] comprising the steps of:
displaying a list of identifiers for at least two of said records [note: element 204]; and

displaying simultaneously content elements of at least one of the records [note: column 14 lines 29-51 "*software 106 display the search result list (or a portion thereof), together with relevance scores ... bibliographical information corresponding to each document*"; element 206 figure 2; figures 4A and 5; col. 12 lines 48-57; col. 14 lines 29-65].

Bar et al. teaches simultaneously identifying document records with a single search query and provides for simultaneous display of content elements [column 4 lines 11-14].

6. Regarding claims 2-4:

(Claim 2) wherein said displayed content elements comprise the entirety of one of said records responsive to a database query [Barr et al., Figure 4A and 5].

(Claim 3) wherein said identifiers comprise case citations [Barr et al., figure 4A and 5].

(Claim 4) further comprising the step of identifying and marking records responsive to a database query displayed in their entirety in a prior database query [Barr et al., 206 figure 2 and figure 4A].

7. Regarding claims 6, 8, and 15 note Barr et al.:

(Claim 6) further comprising the step of sorting said records responsive to a database query [col. 13 lines 30-67].

(Claim 8) wherein said responsive records include a record name;

a record citation; a record date; and a record author [note element 400 figure 5].

(Claim 15) further comprising the step of resolving ties in a preceding sort [col. 13 lines 30-67].

8. Regarding claim 7 note Barr et al.: wherein said records responsive to a database query are legal documents which include a record name ... legal citation ... date ... author [Fig. 5; col. 13 lines 30-67].
9. Regarding claims 9-14, further comprising the step of computing the relevance of said records ... wherein said list of responsive records is sorted according to record name ... citation ... date ... record authors ... relevance of records [Barr et al. Figure 5 note elements 400 430 and 440; Fig. 6B steps 142j through 142L; also note sorting is a part of the scoring or ranking process; col. 3 lines 32-48].
10. The limitations of apparatus claims 21-24, 26-30, 34-39 parallel method claims 1-4 and 6-15 therefore they are rejected under the same rationale.
11. The limitations of claims 50-55, 58-59, 62-67, 71 and 74-75, have been addressed above except for the following: wherein said content elements include paragraphs and means for identifying a most relevant document and an algorithm [note Barr et al. figure 5, 5A, 5B, col. 23 line 10 through col. 24 line 55].
12. Regarding claims 56, 57, 60 and 61 Barr et al. teaches a method for displaying records responsive to a database query on a screen where the records are characterized by having identifiers and content elements [note abstract; figure 2, 3, 4A, col. 22 lines 10-37; note. Barr et al. teaches content elements with identifiers see column 14 lines 29-51]. Barr et al. teaches at least two panels (i.e. windows) to view

the query [col. 22 lines 31-44]; and simultaneous display within panels [col. 15 lines 24-31].

Allowable Subject Matter

13. Claims 16-20 and 40-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barrera et al. US Patent 6,567,800 B1

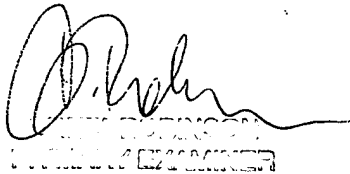
Knight et al. US patent 6,493,703 B1

Sumita et al. US patent 5,907,841

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'G. Robinson', with a horizontal line extending from the end of the signature.

Greta Robinson
Primary Examiner
December 21, 2005